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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/825,578	04/15/2004	Andrew Aaron	728-242	8668
66668 7590 03/10/2010 THE FARRELL LAW FIRM, P.C. - IBM 290 Broadhollow Road Suite 210E Melville, NY 11747				
EXAMINER				
NEWAY, SAMUEL G				
ART UNIT		PAPER NUMBER		
2626				
MAIL DATE		DELIVERY MODE		
03/10/2010		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/825,578

Applicant(s)

AARON ET AL.

Examiner

SAMUEL G. NEWAY

Art Unit

2626

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 December 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7, 9-15 and 18-23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7, 9-15 and 18-23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB-06)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. This is responsive to the amendment after non-final filed on 22 December 2009.
2. Claims 1-7, 9-15, and 18-23 remain pending and are considered below.

Response to Arguments

3. Applicant's arguments filed 22 December 2009 have been fully considered but they are not persuasive.

Applicants argue that modifying the system of Brittan and Silverman based upon Luther is unsupported, so that the Office Action fails to establish a prima facie case of obviousness "as the cited section of Luther teaches nothing beyond what is already disclosed in Brittan and Silverman, so that one of skill in the art would not have been motivated by the cited section of Luther to modify in any way the hypothetical system that one of ordinary skill in the art allegedly would have arrived at based upon the teachings of Brittan and Silverman. Silverman itself specifically teaches that a user may have the option of specifying whether to spell out or pronounce words (see e.g., col. 25, lines 20-23: "This, of course, may be done at the request of the user, although automatic institution of spelling may be useful.")".

The Examiner respectfully disagrees. Silverman, in the cited portion, discloses an option between an automatic or a user initiated spelling. There is no mention of giving the user the option of either spelling or pronouncing a synthesized word. In any case, even if Applicants were correct and Silverman did indeed teach the option of either spelling or pronouncing a synthesized word, then the applicable claims would be

rejected over Brittan in view of Silverman without requiring Luther.

Applicants further argue that "None of the three references relied upon in the rejection remotely teach or suggest inserting a pause within the output of the synthesized speech of an uncommon word to increase its duration by pronouncing the uncommon word in at least two pronounced portions separated by the pause. Therefore, no combination of the teachings of Brittan, Silverman and Luther could remotely teach or suggest this limitation of claim 1".

However, it was a combination of the references that was used to read on Applicants' limitation and one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Further, arguing that since a limitation is not disclosed entirely in one reference then a combination of references may not teach it stands against 35 USC § 103.

Applicants also argue that "Silverman, which is the only reference relied upon by the Examiner that teaches inserting a pause in a synthesized output, teaches doing so during the spelling of word, wherein groups of the individual letters of the word are separated by pauses. (Silverman, col. 12, lines 53-58). That is, the pauses in Silverman separate a spelling of a word and not a pronunciation of the word".

However, Brittan also discloses inserting a pause in a synthesized output ([0065]). And even if it is true that Silverman discloses inserting pauses in a spelling of a

synthesized word, it was the combination of Brittan, Silverman, and Luther which was used to show the limitations in Applicants' claim 1.

Applicants further argue that "The teachings of Luther that it is possible for an operator to select whether unknown words are spelled or pronounced does not remotely suggest any modification to Silverman because (1) Silverman already teaches that a user may select whether to spell or pronounce a word, and (2) the cited teachings of Luther relate only to whether a word is to be spelled or pronounced, and teach nothing whatsoever about how such spelling or pronunciation is to be performed. Stated differently, there is absolutely no support for the assertion in the Office Action that if one of ordinary skill in art followed the teachings of Luther, they would have "used Luther's disclosure to either spell out or pronounce Silverman's synthesized word, thereby either spelling out or pronouncing the portions separated by pauses." (Office Action, page 4). There is simply no teaching or suggestion in either Luther or Silverman that when a word is to be pronounced, that portions thereof be separated by pauses".

However, as presented above, Silverman does not disclose that a user may select whether to spell or pronounce a word, and it was the combination of Brittan, Silverman, and Luther which was used to show the limitations in Applicants' claim 1. Namely, Silverman was used to teach inserting pauses in a spelled synthesized word and Luther was used to teach that in speech synthesis, words can either be spelled or pronounced based on a user selection. Therefore, Silverman in view of Luther teaches inserting pauses in a pronounced synthesized word.

The Examiner's responses above apply to all the other claims.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-7, 9-15, and 18-23 are rejected under 35 U.S.C. 103(a) as presented in the office action mailed 01 October 2009.

Conclusion

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to SAMUEL G. NEWAY whose telephone number is

(571)270-1058. The examiner can normally be reached on Monday - Friday 8:30AM - 5:30PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David R Hudspeth can be reached on 571-272-7843. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/David R Hudspeth/
Supervisory Patent Examiner, Art Unit 2626

/S. G. N./
Examiner, Art Unit 2626